

## **REMARKS**

Claims 1, 2, 5, 6, 9, 12, 14, 17, 18, 20, 23, 25, 28, 29, 45 and 46, as herein amended, and claims 4 and 8 as filed are pending in the application. Claims 13, 15, 16, 24, 26, 27, 35-44, 47 and 48 are cancelled without prejudice or disclaimer. Claims 3, 7, 10, 11, 19, 21, 22, 30-34, 49 and 50 are withdrawn as being directed to a non-elected invention. Applicant respectfully contends that the grounds of rejection set forth in the action with regard to the cancelled claims are rendered moot.

Claims 1, 5, 9 and 20 are object to for reciting certain claim informalities. Applicant has amended these claims to overcome the objections as follows. Claims 1, 5, 9 and 20 have been amended to delete the objected to phrase “a neoplastic disease is detected, inferred or monitored in a human.” Claims 9 and 20 have been amended to delete the objected-to word “defined.” Claim 20 has been amended to replace “plasma or serum” with “noncellular fraction.” Applicant respectfully requests that the Office withdraw these objections in view of his amendments.

Applicant respectfully continues to contend that that prosecution of the pending claims is sufficiently far advanced that completing examination of the two claims grouped outside the claimed group identified by the Examiner would occasion no undue burden on the Office. However, should the Examiner require it, Applicant asks that he cancel the withdrawn claims by Examiner’s amendment when all other grounds of rejection have been overcome.

**1. The claims as amended fulfill the requirements of 35 U.S.C. §112, first paragraph**

Claims 1, 2, 4-6, 8, 9, 12, 14, 16-18, 20, 23, 25, 27-29, 45 and 46 stand rejected for failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph. The Action states that “the claims are enabled for detecting a product amplified from total extracellular RNA from plasma or serum from a human . . .” Applicant has thus amended the claims to overcome these grounds of rejection; claims 16 and 27 has been cancelled without prejudice. Applicant respectfully contends that these amendments overcome the asserted grounds of rejection, and respectfully request the Examiner withdraw these grounds of rejection.

**2. The claims as amended fulfill the requirements of 35 U.S.C. §112, second paragraph.**

Claims 1, 2, 4-6, 8, 9, 12, 14, 16-18, 20, 23, 25, 27-29, 45 and 46 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite. Applicant has amended these claims to overcome

the grounds of rejection as follows. Claims 1 and 5 have been amended to make clear that the human group or population recited in subpart c) is the same as the human group or population without disease. Claims 9 and 20 have been amended to make clear that the reference range of RNA is identical to an RNA tumor-associated species. Claims 12 and 14 have been amended to delete reference to a human group or population. Claims 23 and 25 have been amended to delete reference to a human group or population. Applicant respectfully contends that these amendments overcome the asserted grounds of rejection, and respectfully request the Examiner withdraw these grounds of rejection.

### **CONCLUSIONS**

Applicant believes that all pending claims are in condition for allowance, and respectfully request that the pending claims be passed to issue.

If Examiner Lu believes it to be helpful, he is invited to contact the undersigned representative by telephone at (312) 913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff LLP**

Dated: March 31, 2008

By: /Kevin E. Noonan/  
Kevin Noonan, Ph.D.  
Reg. No. 35,303